

Application No. 10/042,373  
Reply to Office Action of 12/16/2003

Attorney Docket No. 10287.48  
Customer No. 27683

## **REMARKS**

### **STATUS OF CLAIMS**

Claims 22-26 have been amended, and Claims 27-31 have been added. Claims 22-31 are pending in the application. Reconsideration of this application in light of the above amendments and the following remarks is respectfully requested.

### **OBJECTION TO ABSTRACT**

The Office Action objected to the abstract of the disclosure, on the ground that the existing abstract is configured to have two paragraphs, rather than one paragraph. The foregoing amendments convert the abstract from a two-paragraph format to a one-paragraph format. In addition, pursuant to a PTO requirement, Applicant is enclosing a separate sheet which has the amended abstract thereon. It is respectfully submitted that the abstract is now in proper form, and notice to that effect is respectfully requested.

### **ALLOWABLE SUBJECT MATTER**

Noted with appreciation is the indication in the Office Action that dependent Claims 24 and 25 are distinct from the prior art. Claims 24 and 25 were subject to a rejection for indefiniteness under the second paragraph of 35 U.S.C. §112. As discussed later, Applicants believe that the foregoing amendments bring Claims 24 and 25 into conformity with the second paragraph of §112. In addition, since Claims 24 and 25 each previously depended from Claim 22, the foregoing amendments introduce limitations from Claim 22 into each of Claims 24 and 25, in order to place Claims 24 and 25 in independent form. These amendments are not intended to result in any significant change to the scope of Claims 24 and 25. Therefore, and with due regard to the requirements of §112, Claims 24 and 25 are believed to be in proper condition for allowance, and notice to that effect is respectfully requested.

Newly-added Claims 29 and 30 each depend from allowable Claim 24, and newly-added Claim 31 depends from allowable Claim 25. Consequently, Claims 29-31 are also believed to be allowable, and notice to that effect is respectfully requested.

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### SECOND PARAGRAPH OF 35 U.S.C. §112

The Office Action rejected Claims 22-26 under the second paragraph of 35 U.S.C. §112 as indefinite, identifying selected phrases in these claims which were asserted to be problematic. The foregoing amendments implement changes which are intended to ensure that Claims 22-26 are in conformity with the second paragraph of §112. However, the Office Action raised one ground of rejection under §112 which Applicants respectfully traverse.

More specifically, the Office Action objected to the phrase "capable of" in Claim 22. Applicants respectfully traverse this ground of rejection, for the following reasons. First, the Examiner states that "it is unclear of what is being modified for the carriers to be capable of holding micro-substances and the remotely-acting bodies". However, this statement appears to be inconsistent with the actual language of Claim 22. For example, Claim 22 does not include any recitation that anything about the carriers is being "modified" in order to provide the carriers with this capability. Moreover, it is noted that language such as "capable of", "incapable of", or "adapted to" is not inherently objectionable, for example as reflected by MPEP §2173.05(g). Applicants have carefully reviewed the clause in Claim 22 which includes the phrase "capable of", and respectfully submit that this clause is properly definite under §112.

In light of the amendments to the claims, as well as the foregoing remarks regarding §112, it is respectfully submitted that Claims 22-26 are now in compliance with §112, and notice to that effect is respectfully requested.

### PATENTABILITY OF INDEPENDENT CLAIM 22

Independent Claim 22 was rejected under 35 U.S.C. §102 as anticipated by Forrest US Patent No. 4,659,678. However, this ground of rejection is respectfully traversed, for the following reasons. The PTO specifies in MPEP §2131 that, to anticipate a claim, a reference must teach every element of the claim. In the present application, Claim 22 has limitations which recite:

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. . . pouring remote-acting bodies which can be positionally manipulated by a remote force, micro-substances including a target substance of an assay, and carriers capable of holding the micro-substances and the remote-acting bodies, into a liquid, a gas or a solid in accordance with a predetermined order,  
making the remote-acting bodies and the micro-substances be held in the surfaces of the carrier by agitating the suspension system, . . .

To support the rejection of this language from Claim 22, the Forrest patent must disclose each and every element recited in this language. However, it is respectfully submitted that the Forrest patent fails to do so, and therefore does not anticipate Claim 22 under §102. Claim 22 is thus believed to be allowable, and notice to that effect is respectfully requested.

#### DEPENDENT CLAIM 27

Claim 27 is a newly-added claim, which depends from Claim 22. Claim 27 recites:

. . . configuring the carriers to have a plurality of holes, cavities, concavities or convexities with a size capable of holding the micro-substances and the remote-acting bodies, the agitating causing the micro-substances and the remote-acting bodies to become fixed within the holes, cavities, concavities or convexities of the carriers.

As noted above, in order to anticipate Claim 22 the Forrest patent would have to disclose each and every element recited in this quoted language. It is respectfully submitted that the Forrest patent does not do so. Accordingly, Claim 22 is believed to be allowable over Forrest, and notice to that effect is respectfully requested.

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### DEPENDENT CLAIM 28

Claim 28 is a newly-added claim which depends from Claim 22. Claim 28 includes a recitation of:

. . . prior to the pouring, separately preparing the carriers, the remote-acting bodies, and the micro-substances.

As discussed above, in order to anticipate Claim 28 the Forrest patent must disclose each and every element recited in this quoted language. It is respectfully submitted that the Forrest patent does not do so. Claim 28 is therefore believed to be patentably distinct from Forrest, and notice to that effect is respectfully requested.

### DEPENDENT CLAIMS 23 AND 26

Claims 23 and 26 depend from and further limit independent Claim 22, and are also believed to be allowable, for example for the same reasons discussed above with respect to Claim 22.

### CONCLUSION

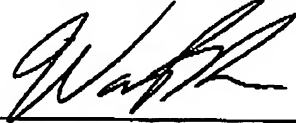
Claims 22-31 are under consideration in the present application. In view of the foregoing amendments and remarks, allowance of Claims 22-31 is respectfully requested. The Examiner is invited to call the undersigned at the below-listed

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telephone number if, in the opinion of the Examiner, such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

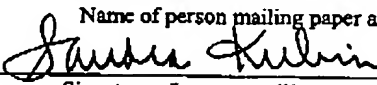


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EXPRESS MAIL NO.: <u>EV333443962</u> <u>us</u>
DATE OF DEPOSIT: <u>May 21</u> , 2004
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<u>Sandra Kubin</u>
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